

REMARKS

Claims 1-3, 5-16, 18-19 and 21-40 are pending in the application.

In this response, claims 1, 14, 30 and 40 are amended to include language consistent with original claim 12, which specified that light enters the lightguide in a direction substantially coplanar with and normal to the longitudinal axes of the conduits. Accordingly, claim 12 is cancelled. Claims 1, 14, 29-30 and 40 are also amended to clarify that the light is emitted in this direction by a light source.

In view of the above amendments and the following remarks, Applicants request further examination of the application and reconsideration of the rejections set forth in the Office Action dated November 25, 2005.

Claim Rejections Under 35 U.S.C. § 112

A. In the Office Action, page 2, claims 1-3, 5-16, 18-19 and 21-40 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. As support for this rejection it is contended that it is unclear how a light source would be positioned in relation to the light guide to enable the function recited in the claim.

As noted above, in response to this rejection Applicants have amended independent claims 1, 14, 30 and 40 for purposes of clarification. The present application is clear that light enters the lightguide in a direction substantially coplanar with and normal to the longitudinal axes of the conduits.¹ Independent claims 18 and 29 as previously presented clearly state the relationship between the light entering the light guide and the conduits within the light guide.

The legal standard for definiteness is whether a claim, read in light of the specification, reasonably apprises those of ordinary skill in the art of its scope.² Applicants respectfully submit that claims 1, 14, 30 and 40 as amended, and claims 18 and 29 as previously presented, particularly point out and distinctly claim the subject matter as required by the second paragraph of 35 U.S.C. § 112.

¹ See, for example, page 9, lines 12-15 and Fig. 1, as well as original claims 12, 18 and 29.

² See, e.g. *In re Warmerdam*, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 USPQ 634, 641 (Fed. Cir. 1985).

B. In the Office Action, pages 2-3, claims 1-3, 5-16, 18, 19 and 21-40 are also rejected under U.S.C. § 112, second paragraph, as incomplete for omitting essential elements, such omission amounting to a gap between the elements. As grounds for this rejection, as understood, it is contended that the claim does not positively recite a light source or its position in relation to the lightguide

In response to this rejection, independent claims 1, 14, 30 and 40 are amended to clarify that the light is emitted by a light source. However, these claims are directed to an analytical cell, not an analytical device, so it is respectfully submitted that the light source is not an essential element of the claim. It is well settled that it is entirely consistent with the second paragraph of 35 U.S.C. § 112 to present subcombination claims drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention.³ There is no requirement that a claim recite each and every element needed for the practical utilization of the claimed subject matter.⁴

In addition, claims 1, 14, 30 and 40 as amended specify how light from a light source enters the lightguide, so one of ordinary skill in the art would be aware that these claims cover any lightguide structure that would internally reflect light entering the cell in a direction substantially coplanar with and normal to the conduits to illuminate the conduits for detection of an analyte. Further to the discussion in Section A above, Applicants respectfully submit that this is sufficient to comply with the requirements of the second paragraph of 35 U.S.C. § 112.

Independent claim 18, which is directed to analytical device, clearly recites as an element a light source outside the lightguide that emits a light beam having an optical axis substantially coplanar with and normal to the longitudinal axes of the grooves carrying the analyte. Applicants respectfully submit that this is sufficient to satisfy the requirements of the second paragraph of 35 U.S.C. § 112.

Independent claim 29, which is directed to an analytical method, as amended includes the step of illuminating the lightguide with light source, wherein the light source emits a light beam having an optical axis along a second direction substantially coplanar with the plane of the grooves and normal to the direction of analyte flow. It is clear from this language how the light

³ See, e.g. *Carl Zeiss Stiftung v. Renishaw plc*, 20 USPQ2d 1095, 1101 (Fed. Cir. 1991).

⁴ *Id.*

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source is arranged with respect to the analytical cell to accomplish the claimed method, so Applicants respectfully submit that this claim as amended satisfies the requirements of the second paragraph of 35 U.S.C. § 112.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims.

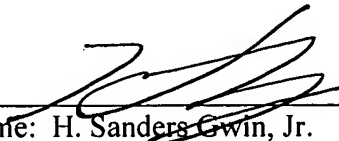
Please charge any additional fees or credit any overpayment to deposit account number 50-1778. If questions remain regarding the above, or if the Examiner wishes to discuss any aspect of this response, please contact the undersigned.

Date:

By:

April 25, 2006

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